

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application. Claims 1-11 remain in the application and claim 1 is independent.

The Office Action dated April 6, 2009 has been received and carefully reviewed. Each issue raised in the Office Action is addressed below. Reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Objections to the Specification

The Office Action objects to the Abstract of the Invention for being too long and requires correction. Responsive thereto, Applicant has provided an amended Abstract of the Invention which is believed to comply with USPTO guidelines. Reconsideration and withdrawal of the objection are respectfully requested.

Rejections – 35 U.S.C. § 101 – Double Patenting

Claims 1-11 stand rejected under 35 U.S.C. § 101 as allegedly being directed to the same invention as that claimed in U.S. Pat. No. 7,217,233. This rejection is respectfully traversed.

MPEP § 804, subsection A., directed to Statutory Double Patenting under 35 U.S.C. § 101 specifies in part:

“In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? **35 U.S.C. 101** prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under **35 U.S.C. 101** is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

Independent claim 1 of the present application specifies that the brush guide is disposed along the circumferential surface of the first cylinder located "upstream", in the rotating direction, of the point of contact between the first cylinder and the second cylinder. See the second subparagraph under the claim 1 preamble, on page 21 of the instant application as filed. Independent claims 1 and 11 of U.S. Pat. No. 7,217,233, on the other hand, explicitly state that a stationary guide is located "downstream", in the rotating direction, of the point of contact between a first cylinder and a second cylinder. Moreover, in connection with the moving guide, U.S. 7,217,233 clearly recites that the moving guide is provided on the same side as the stationary guide with respect to the point of contact between the first cylinder and the second cylinder, in light of the following definition of a remote position: the definition of the close position "where said moving guide is moved to a position closer to the circumferential surface of said first cylinder and the circumferential surface of said second cylinder than said stationary guide **inside an area defined by said first cylinder, said second cylinder and said stationary guide**" and the definition of the remote position "said moving guide is moved to a position **as remote as, or outside said area and more remote than, said stationary guide**".

Therefore, because the present application specifies the guide as "upstream" of the point of contact between the first cylinder and the second cylinder, and because U.S. 7,217,233

specifies “downstream”, the instant application and the applied patent are clearly different in scope and cannot constitute “same invention” double patenting. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim Rejections – 35 U.S.C. § 103

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over JP 2002-60128 in view of JP 2-221063. Applicant submits the Examiner has failed to establish a *prima facie* case of obviousness and respectfully traverses the rejection. A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the cited references must teach or suggest each and every element in the claims. See MPEP § 706.02(j); MPEP §§ 2141-2144.

Applicant respectfully submits that this rejection is improper for a number of reasons. First, the base reference to JP 2002-60128 is directed to a parallel folding apparatus of a folding machine, but which neither describes nor suggests a brush guide which is a feature of the present invention, as recited. Instead, the base reference discloses a changeover device for the sheet material carrier path provided with a folding drum 3, a grip drum 4 having grip boards 5a-5d, gripping claws 12a-12d, an upper decelerating drum 7, grip claws 14b and 14d and a lower decelerating drum 8. Thus, the base reference JP 2002-60128 is significantly different than what is claimed and, in no way, discloses or suggests the claimed invention.

Second, the secondary reference JP 2-221063 appears to disclose a parallel folding apparatus of a folding machine having a brush guide. However, this brush guide is provided “downstream”, in the cylinder rotating direction, of the point of contact between the two cylinders 17 and 18. This position is completely different from the position of mounting of the brush guide recited in the claims of the present application. The brush guide of ‘063 is intended to hold down a cut paper 26, which is released from a pin 25 and freed and whose travel direction is reversed, so that the leading end P of the cut paper 26 does not flutter. See Figures 1, 5 and 8, for example. The brush guide of the present invention, on the other hand, is aimed at preventing the situation that when the signature is parallel-folded between the first cylinder and

the second cylinder, the rear end of the signature is bent, deteriorating folding accuracy. The brush guide of the present invention and the brush guide of '063 are different as to the position of disposition and as to the problems to be solved.

Even if the brush guide of '063 were to be added to the folding machine of '128, this brush guide is "downstream" in the rotating direction of the point of contact between the first cylinder and the second cylinder, and thus cannot be said to show or suggest the claimed invention. Moreover, even if it were possible to make the modification proposed in the rejection, which we do not admit, the rejection of record has failed to provide any of the factual analysis necessary that might lead to such a proposed modification, as using a "downstream" brush guide upstream of a changeover device.

Applicant notes that the Examiner has taken the position at the bottom of page 3 of the Office Action that "the exact location of the brush guide in respect to the jaw cylinder is nothing more than an **engineering design choice to locate the parts.**" (emphasis added) Applicant has carefully reviewed all of the possible ways detailed in MPEP §§ 2142 and 2143 in which it might be possible to support an obviousness finding, and respectfully submits that "engineering design choice" cannot properly be used to provide motivation. To the contrary, these sections of the MPEP clearly require that "Office personnel must resolve the *Graham* factual inquiries" and articulate them. That has not happened on this record. The rejection has failed to establish any fact finding or any "rationale" necessary to support *prima facie* obviousness. The Office has the burden of providing objective factual evidence that what is claimed is obvious over the applied art. All the Office Action presents in support of this aspect of the rejection is an unsupported speculative conclusion and it is well settled that a rejection may not be properly based on speculation such as this. It is well settled that a rejection under 35 U.S.C. §103 cannot properly be based on speculation but must be based on objective factual evidence of record. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). See, also, *In re GPAC Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* The secondary reference JP 2-221063 neither discloses nor suggests either the location or the problems solved by the present invention, and therefore cannot remedy the defects of JP 2002-60128, as recited in original claim 1, from which claims 2-11 depend. Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 1-11. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All objections and rejections raised in the Office Action having been properly traversed and addressed, it is respectfully submitted that the present application is in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Notice of same is earnestly solicited.

Prompt and favorable consideration of this Amendment is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Paul T. Sewell, Registration No. 61,784, at (703) 205-8000, in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

Charles Gorenstein

Registration No.: 29,271

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant